

REMARKS

Claims 14-17 and 27-31, 33-38, 40-45, and 47-48, as amended, are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claim 14 has been rewritten to further clarify that the method applies to golf shoes and the particular parameters relating to the selection of golf shoes. In addition, claims 42-48 have been added to recite additional embodiments of the invention, which are fully supported by the Written Description. *See, e.g.*, Page 7, line 34 to Page 8, line 2; Page 8, lines 21-25; and Page 10, lines 7-19. As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

THE REJECTION UNDER 35 U.S.C. § 112

The Examiner rejected claims 14, 27, 35, and 40 under 35 U.S.C. § 112, second paragraph as provided on pages 3-4 of the Office Action. In particular, the Examiner rejected claim 14 for the use of the phrase “the group consisting of” and the use of the term “the computer network.” In response, Applicants have amended claim 14 to clarify that the previously used phrase “the group consisting of” was intended to further define the choices of the first parameter. In addition, the claim has been amended such that the computer network has antecedent basis. Claim 35 has been rewritten in a similar manner.

With regard to the Examiner’s rejection regarding the use of the method step “submitting the order from through the at least one computer” in claim 27, Applicants respectfully submit that this claim has been rewritten in a similar fashion as claims 14 and 35. Finally, with regard to the Examiner’s rejection of claim 40, Applicants respectfully submit that the term “pattern” is clearly described in the Written Description at page 7, line 34 to page 8, line 9. In particular, the pattern is a type of material treatment, included in the same sub-group as temperature responsive treatments, stain-proofing, and waterproofing, and can be, for example, a type of stitching or weave. *Id.* As such, it is not clear to the Applicants how this term is considered vague or indefinite.

In light of the amendments and remarks herein, Applicants respectfully submit that the § 112 rejection is overcome. Reconsideration and withdrawal of the § 112 rejection is respectfully requested.

THE REJECTIONS UNDER 35 U.S.C. § 103

Claims 14-17, 27-31, 41, and 46-47 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Publication No. 2001/0020222 to Lee in view of U.S. Patent No. 5,887,363 to Rhodes for the reasons provided on pages 4-9 of the Office Action. In addition, claim 32 was rejected under § 103(a) as obvious over Lee and Rhodes further in view of Hersey as discussed on pages 9-10 of the Office Action. The Examiner also rejected claims 33 and 42 under § 103(a) as obvious over Lee and Rhodes further in view of U.S. Patent No. 6,127,010 to Rudy as set forth on pages 11-12 of the Office Action. Claims 34 and 43 were also rejected under § 103(a) as obvious over Lee and Rhodes further in view of U.S. Patent No. 5,144,899 to Allen. The Examiner also rejected claims 35-37 and 48 under § 103(a) as obvious over Lee and Allen as provided on pages 13-15 of the Office Action. Claims 38, 39, and 40 were rejected under § 103(a) as obvious over the Lee / Allen combination further in view of Rudy, Hersey, or U.S. Patent No. 6,861,396 to Baker, respectively. Claims 44 and 45 were rejected under § 103(a) as obvious over the Lee / Rhodes combination further in view of Baker or U.S. Patent No. 6,092,605 to Cisneros for the reasons provided on pages 18-20.

As a threshold matter, Applicants recognize that the test for obviousness is not whether the features of the secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Young*, 927 F.2d 588,591 (Fed. Cir. 1991). In this case, no combination of the cited references suggests the presently recited invention without the use of impermissible hindsight. In fact, only the instant application provides the requisite motivation with which to combine the references in the manner suggested by the Examiner.

In particular, it is clear that the primary reference Lee is deficient in several ways with respect to the present invention at least because Lee does not teach or even suggest a method of soliciting or placing an order for golf shoes. Accordingly, Lee is completely silent as to cleat type, traction level, material treatment, and the like. And, while the Examiner uses various references to

supplement Lee's deficiencies with respect to the majority of the recited invention, a skilled artisan would have lacked any motivation to combine all of these references without the instant application to use as a template.

For example, while Rhodes is cited by the Examiner for its disclosure of various cleat types, the reference is silent as to a method for soliciting or placing an order for a golf shoe or consideration of other parameters now recited in the independent claims. Hersey is cited by the Examiner for its disclosure regarding selection of nylon mesh or 200 denier nylon for the insole and various rubbers for the outsole. Office Action at Page 10. However, Hersey does not even suggest the use of such selection processes with regard to golf shoes.

Likewise, Rudy teaches various shock absorbing cushioning devices for footwear (Col. 3, lines 43-45), but is completely silent as to their application in golf shoes. Allen generally discloses an embroidery / screen printing apparatus for textile substrates (Col. 2, lines 1-16), however, the reference is silent as to its application on golf shoes or any of the other features of the invention.

Baker is similarly narrow with regard to the numerous deficiencies of the primary reference. For example, Baker is cited by the Examiner merely for its disclosure of various treatments for shoes. Pages 17-18. Like the other references, however, Baker does not even contemplate such treatments in the ordering process for golf shoes. Finally, Cisneros generally discloses a horseshoe traction device (Col. 2, lines 44-57), which is not even related to the type of traction level contemplated for golf shoes. As such, a skilled artisan would not have even contemplated this reference with regard to golf shoes.

In sum, none of the references remedy the deficiencies of Lee including teaching a method of soliciting or placing an order for golf shoes. As such, not only would a skilled artisan have lacked any motivation to combine the references in the manner suggested by the Examiner, such combination would not have resulted in the presently recited method.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection based thereon.

CONCLUSION

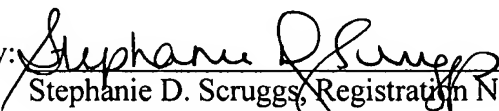
All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the

pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response one month to and including October 22, 2007. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 50-4047, Order No. 20004.0008.

Respectfully submitted,
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